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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,970	12/31/2001	John E. Gozum	56855US002	8629

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EXAMINER

TRUONG, BAO Q

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039,970

Applicant(s)

GOZUM ET AL.

Examiner

Bao Q. Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a jacket layer" in claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

2. Claim 1 is objected to because of the following informalities: "a light source" on line 5 should be changed to --the light source-- or --said light source--; "the optical elements" should be changed to --the at least one optical element--.

Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-8 and 11-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-6, 8, 10 and 14-15 of U.S. Patent No. 6,267,492. Although the conflicting claims are not identical, they are not patentably distinct from each other, and which are described in the table below:

Application Claims	Patent Claims	Discussion
1	1, 6	The light guide is read on the optical fiber; the glare shield is read on the continuous outer cladding layer.
2	8	A plurality of structure elements is read on the optical elements
3	3	Identical
4	4	Identical
5	5	Identical
6	1	Identical
7	1	Identical
8	4, 10	Identical
11, 12	8	A plurality of structure elements is read on at least three optical elements

13-16	8	A plurality of structure elements is read on the optical elements. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the size of the optical elements and the size of the light fiber.
17	1, 14, 15	The sleeve is read on the jacket layer. The combination of 1, 14 and 15 meet the claim; It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the sleeve to cover the optical fiber for purpose of providing an advantageous way to control light direction.

5. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,267,492 in view of R.B. Thomas [US 2,431,091].

R.B. Thomas teaches the use of a flashlight [1] as a light source to transmit light into a fiber optic [12] (figure 1).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the flashlight as a light source as taught by R.B. Thomas for purpose of providing a light weight light source.

6. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,267,492 in view of Zarian et al. [US 5,298,327].

Zarian et al. teach the use of material fluorinated ethylene-propylene in a plastic light conduct (column 19 lines 35-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use FEP material as taught by Zarian et al. for purpose of providing an advantage of using its index value.

7. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,267,492 in view of Lundin et al. [US 5,845,038].

Lundin et al. teach the use of reflective surfaces [32, 34] on an optical element [30] of an optic fiber [20] (figures 4 and 6, column 5 lines 8-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the reflective surfaces on the optical element as taught by Lundin et al. to reflect more light downwardly for purpose of providing a wider illumination.

#### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-8, 11, 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Reid et al. [US 6,267,492].

Regarding claim 1, Reid et al. disclose a light source [10], a light fiber [20] with an input end and an output end, a light emitting region with an optical element [126] and a continuous outer cladding layer [636] (figures 1-3 and 6).

Regarding claim 2, Reid et al. disclose two or more optical elements [126] (figure 3).

Regarding claim 3, Reid et al. disclose the length of the light emitting region being less than the length of the light fiber (figures 1, 6, 7).

Regarding claim 4, Reid et al. disclose the light emitting region being less than 360 degrees (figure 5).

Regarding claim 5, Reid et al. disclose the light emitting region being less than 180 degrees (column 10 lines 65-67).

Regarding claim 6, Reid et al. disclose the light fiber [20] being rotatably (figure 1).

Regarding claim 7, Reid et al. disclose the light fiber [20] being detachably (figure 7).

Regarding claim 8, Reid et al. disclose the light fiber [20] emitting light from both the output end and the light emitting region (figure 1).

Regarding claims 11 and 12, Reid et al. disclose three optical elements [126] (figure 3).

Regarding claim 17, Reid et al. disclose a jacket layer (figures 5 and 6).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9, 10, 13-16 and 18 rejected under 35 U.S.C. 103(a) as being obvious over Reid et al.

The applied reference has a common assignee 3M Innovative Properties Company and a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or

declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The using of the flashlight, the FEP material, the sizes of optical elements and light fiber, and reflective surfaces of optical elements would be obvious in view of a change in size of an element, and in view of Zarian et al., R.B. Thomas, and Lundin et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (703) 308-6452. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

Bao Q. Truong  
Examiner  
Art Unit 2875

BQT  
March 25, 2003



Sandra O'Shea  
Supervisory Patent Examiner  
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